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| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER YU, GINA C | |
| | | | ART UNIT 1611 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/533,361

Applicant(s)

TOUMI ET AL.

Examiner

GINA C. YU

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 16, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 19, 24-29, 31-33, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 19, 24-29, 31-33, 48, 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment filed on September 16, 2009. Claim 18 has been canceled; Claims 1, 3, 19, 24-29, 31-33, 48, and 49 are now pending.

The claim rejection made in the previous Office action dated March 16, 2009 is withdrawn in view of the applicant's remarks in part and has been modified as discussed below.

Claim Rejections - 35 USC § 103 (New)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 19, 24-29, 31-33, 48, and 49 are rejected as unpatentable under 35 U.S.C. § 103 (a) over Kumar et al. (US 5468477).

Kumar teaches a face cream composition comprising 2 % by weight of the vinyl-silicone graft polymer of instant claims 1 and 3. See Example 27; instant claims 31-33, 48 and 49. In the mercapto functional silicone compound shown in col. 4, line 50 – col. 5, line 16, G5, and G6 can be ZSA, wherein A represents a vinyl polymeric segment consisting essentially of polymerized free radically polymerizable monomer, and Z is a divalent linking group, preferably methylene or propylene for reasons of commercial availability. Alternatively, R2 and R4 of the Kumar polymer being C3 alkylene and G2 comprising A (vinyl polymer) also meets the thiopropylene linker limitation. The graft copolymer used in the facial cream composition of Example 27 is 3-mercaptopropylmethylsiloxane (PS850 from Huls America, Inc.) having ethylhexyl methacrylate and n-butyl methacrylate monomers (both alkyl (meth)acrylates). See

Example 3. The copolymers which meet the present claim limitations “poly(metha)acrylic acid)” and “poly (alkyl (meth)acrylate)” of instant claims 1 and 3 are shown in Example 1 and 2, which employ acrylic acid and t-butyl acrylate monomers. The reference further teaches the softness or hardness of the monomers is well known, and suggests that selection of the suitable soft and/or hard monomers to manipulate the film strength would have been well within the skill in the art. See col. 18, lines 19-64. The ethylhexyl acrylate monomer of Example 3, which is used in Example 27, is known as a soft monomer. See *Id.* The reference particularly teaches that the hard monomers provides “tensile strength and also reduces tack in the copolymer”, and include acrylic acid and methacrylic acid ester of an alkyl monoalcohol containing 1-6 carbon atoms. See col. 15, lines 50 – col. 16, line 8.

Kumar teaches that decorative cosmetics are “used to hide small blemishes or symptoms of aging”. See col. 1, lines 57 – 61. The reference states, “[t]heir sole purpose is an alteration of the appearance, for example, . . . preparation for masking skin imperfection and shininess. . . etc”. See col. 1, line 67 - col. 2, line 3. The reference also teaches that the prior art cosmetic compositions may comprise active ingredients such as “skin-improvers”. See col. 25, lines 10-29. The vinyl-silicone copolymers of Kumar are used to make a gel composition, and said to also have “excellent film-forming capability”, exhibiting a superior water-resistance, oil-resistance, and other characteristics required for cosmetic films”. See col. 17, line 30 – col. 18, line 24. The reference also teaches using preferably 0.2-30 % by weight of vinyl-silicone copolymer to realize the desired cosmetic film property. See Examples 43—50. See

also col. 17, lines 56-66; col. 19, lines 4-13. See instant claims 19, 25, 26, and 31-33. Kumar further suggests that the grafted vinyl-silicone copolymer gives a good adhesion to a substrate and retains its shape-retention property in virtue of the hard monomers which renders the grafted copolymers tensile strength. See col. 15, line 47- col. 16, line 14.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kumar by formulating a skin cosmetic composition incorporating the mercaptopolydimethylsiloxanes having acrylic acid and n-butyl methacrylate monomers of Examples 1. The skilled artisan would have been motivated to do so because the reference teaches specific examples of a skin care product in Example 27 and provides detailed benefits of the prior art film-forming vinyl-silicone graft copolymers, which include "excellent film-forming capability", superior resistance to water and oil, "thick-film sensation" and otherwise suitable for cosmetic films. The motivation to use polymethacrylic acid and poly alkyl methacrylate monomers, such as in Examples 1 and 2, would have been obviously found in the teaching that acrylic acid and t-butyl (meth)acrylate both form hard films which renders the grafted copolymers tensile strength and eliminates tackiness of the film. Thus, by substituting the copolymer used in Example 27 with the polymers of Examples 1 or 2, the skilled artisan would have had a reasonable expectation of successfully producing a cosmetic skin composition which produces films with improved tensile strength and reduced tackiness.

The skilled artisan would have been motivated to use this composition to hide symptoms of aging and skin perfection, such as wrinkles, because Kumar teaches that the "sole purpose" of decorative cosmetics is to alter the appearance of skin, such as hiding symptoms of aging and masking skin imperfection. While these statements in the reference (col. 1, bridging par.) refer to the purpose of using any decorative skin cosmetic in general, the reference nonetheless would have motivated a skilled artisan to use the Kumar cosmetic compositions for the very purpose of hiding symptoms of aging and skin imperfection just as applicant has done in this case, with a reasonable expectation of success.

Furthermore, one of ordinary skill in the art using the Kumar cosmetic composition comprising the grafted silicone polymer of the instant claims would have obviously observed and noticed that the presently claimed methods of reducing the signs of cutaneous aging and wrinkles are naturally carried out when the prior art composition is applied onto skin. The prior art suggests the same method step of topically applying the same vinyl-silicone grafted copolymer of instant claims, thus the appearance of the presently claimed skin wrinkle reduction would have obviously occurred when the prior art composition was in use.

Response to Arguments

Applicant's arguments filed on September 16, 2009 have been fully considered but they are moot in view of new grounds of rejection in part and not persuasive in part.

Applicant argues that Kumar fails to render the present claims obvious because the reference does not specifically indicate the utility of the disclosed copolymers on

skin having signs of cutaneous aging or specifically applying the compositions to wrinkled skin. The argument is persuasive and now rendered moot in view of the new grounds of rejection as discussed above.

Applicant also states the Office has taken that position that the application of the prior art polymers in hair care products renders the presently claimed method obvious. The argument is factually incorrect because the reference explicitly indicates that the disclosed utility and benefits of the film-forming properties of the vinyl-silicone grafted copolymers are obtained from to both hair and skin care applications. The passage cited in the rejection, col. 25, lines 10 – 19, refers to the application of the prior art in "the cosmetic composition" which include "basic cosmetics, makeup cosmetics" as well as hair cosmetics. See col. 25, lines 11-12. The utility of the copolymers in hair care compositions is taught in col. 23, lines 60 – col. 25, line 9, and is not directly relied upon as the basis of the present rejection. For example, in col. 4, lines 14-22, the reference describes the distinctive properties of the prior art compositions as applied to each of hair and skin products. The utility of the prior art film forming polymers in skin cosmetic products has been already taught and suggested by Kumar, and examiner maintains the position the presently claimed methods are obvious over the prior art as discussed above.

In response to applicant's reference to the September 20, 2006 and May 14, 2008 Rule 132 declarations, examiner reiterates that the comparison test results in the declarations do not adequately show unexpected result of the present invention. In both cases, the film-forming grafted copolymer of the present invention (Composition A) was

compared to a conditioning foaming agent (Composition B) and film-forming agents (Compositions C and D) which, according to the declarant, are not grafted copolymers. According to the declaration, Composition B is not even a film forming polymer, but a foaming agent, thus no tensioning/tightening effect is expected from this component. According to Kumar, 2-ethylhexyl acrylate and butyl acrylate in the Composition C and D polymers, respectively, form soft film. See Kumar, col. 18, lines 61-64. Thus the weaker films formed by these comparative polymers are not surprising. On the other hand, methyl methacrylate and methacrylic acid monomers are notoriously known as hard monomers. See col. 18, lines 58-60; col. 15, lines 48 – 53. Thus the superior tensile strength of Composition A as seen in the declarations is an obvious result of comparing the vinyl-silicone grafted copolymers having hard monomers with non-grafted silicone copolymers with soft monomer(s).

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/
Primary Examiner, Art Unit 1611